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EXAMINER

PREVIL, DANIEL

ART UNIT	PAPER NUMBER
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2636

DATE MAILED: 12/30/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/932,065

Applicant(s)

WALLACE, TERENCE

Examiner

Daniel Previl

Art Unit

2636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to communication filed on May 8, 2003.

#### ***Claim Objections***

1. Claims 2, 6, 11, objected to because of the following informalities: Claim 2, line 14 the phrase "upon" must be deleted and substitute it by ---until---  
Claims 6, 11, the phrase "may" in both occurrences must be deleted.
2. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 1-2, the phrase "continuously monitoring the strength of the signals" considers as a new matter because it was not described in the specification.

Claims 3-7 are rejected for the same reason since they depend from rejected claims.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 3, 5, 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over LaRosa (US 5,402,104) in view of Russo et al. (US 5,640,144).

Regarding claim 1, LaRosa discloses a housing (briefcase) includes a signal processor (transponder logic 29), a circuit arrangement (fig. 1 and fig. 2) and a energy source (battery 64) (col. 2, lines 7-48); an attachment device where the attachment device attaches the housing to the object (attach to a key ring by key ring attachment ear 12, the transponder-pager 30 attach to a belt using attachment clip 44) (col. 2, lines 9-12); a remote (30) where the remote transmits and receives signal to and from the signal processor, (transponder-pager 30, transmission by transponder of query signal, reception by transponder of response signal) (col. 2, lines 11-26); wherein the signals include at least one of digital and analog signals (on-off switch 42, frequency selector switch 36) (col. 2, lines 11-17); an input arrangement wherein the input arrangement enables a user to input commands to the circuit arrangement and signal processor, where the commands set at least one operation mode for the security device (on and off and channel selections are inputs for commands for asset protection transponder

10) (fig. 1, col. 2, lines 26-51); and output arrangement where the output arrangement produces an output based on the input commands (transponder pager can sound an audible, speech synthesized, alarm that tells the user which of the assets is now out of range) (col. 1, lines 33-47).

LaRosa discloses all the limitations above but fails to explicitly disclose the signal processor continuously monitors a strength of the signals.

However, Russo discloses the signal processor continuously monitors a strength of the signals (logic unit 7 continuously monitors ultrasonic signals for better receiving the ultrasonic signals) (col. 2, lines 3-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Russo in LaRosa. Doing so would provide the system with the capability of monitoring continuously a personal article to prevent the article from being stolen so users can acquire peace of mind while using this system because it may ensure against theft of valuable personal articles as taught by Russo (col. 1, lines 7-62).

Regarding claim 2, LaRosa discloses setting operational parameters of the security device (10) (receiver 20 will only respond to this signal if the signal receives matches the frequency set the frequency control switch 16) (col. 2, lines 39-63); continuously transmitting a signal from an attachment device to a remote device (col. 2, lines 11-51); setting a minimum signal strength parameter wherein minimum signal strength equals a triggering signal (col. 2, lines 52-68; col. 3,

lines 1-7); detecting a triggering signal based on the operational parameters (this signal will only be detected if it is on the frequency automatically set by scanning logic circuit 52) (col. 2, lines 57-67); selecting an output response based on the operational parameters (alerted in two ways: audibly and visually) (col. 2, lines 60-68; col. 3, lines 1-7); executing the output response for at least one of predetermined period of time and upon receipt of stop output command from the user (alarm output causes display logic circuit 60 to display alphanumeric output , user can verify at any time and depressing test button 34) (col. 3, lines 1-20).

LaRosa discloses all the limitations above but fails to explicitly disclose continuously monitoring signal.

However, Russo discloses continuously monitoring signal (col. 2, lines 3-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Russo in LaRosa. Doing so would provide the system with the capability of monitoring continuously a personal article to prevent the article from being stolen so users can acquire peace of mind while using this system because it may ensure against theft of valuable personal articles as taught by Russo (col. 1, lines 7-62).

Regarding claim 3, LaRosa discloses the remote 30 is concealed within a small portable item (briefcase) (fig. 2; col. 2, lines 6-17).

Regarding claim 5, LaRosa discloses upon the detection of a diminished signal strength based upon an operation mode, the remote emits at least one of an audible alarm, a visible alarm and a vibrating response (once a signal falls below its preset threshold the user is alerted in two ways: audibly and visually) (col. 2, lines 67-68; col. 3, line 1).

Regarding claim 7, LaRosa discloses output response includes at least one of an audible alarm (col. 2, lines 67-68).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaRosa in view of Russo and further in view of Terkilsen (US 5,115,893).

Regarding claim 4, LaRosa and Russo disclose all the limitations in claim 3 but fail to explicitly disclose the small portable item is at least one of an ink pen, a tie pin and hair pin.

However, Terkildsen discloses a small portable item is one ink pen (abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Terkildsen's ink pen in LaRosa and Russo in order to detect accurately the movement of the ink pen and alert immediately authorities to prevent the ink pen from being stolen so users can acquire peace of mind when using this device as taught by Terkildsen (col. 4, lines 16-44).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaRosa in view of Russo and further in view of D'Angelo (US 5,963,131)

Regarding claim 6, LaRosa and Russo disclose all the limitations in claim 1 but fail to explicitly disclose the circuit arrangement includes a microprocessor and a memory arrangement, where the memory arrangement may store data and software that enable the functions of the circuit arrangement.

However, D'Angelo discloses the circuit arrangement 22 includes a microprocessor 32 and a memory arrangement (RAM 13), where the memory arrangement may store data and software that enable the functions of the circuit arrangement (fig. 1; fig. 3; col. 5, lines 28-47; col. 10, lines 25-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of D'Angelo in LaRosa and Russo. Doing so would have provided the system with the capability of storing functions of the device in order to issue an alert if a theft is subsequently attempted so users can take appropriate cautious to avoid the article from being stolen as taught by D'Angelo (col. 3, lines 10-41).

5. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaRosa in view of D'Angelo (US 5,963, 131).

Regarding claim 8, LaRosa discloses a housing (briefcase) wherein the housing includes a signal processor (transponder logic 29); a circuit arrangement (security device) and energy source (battery) (fig. 1-fig. 3; col. 2, lines 6-51); an



attachment device where the attachment device attaches the housing to the object (col. 2, lines 11-12); an input arrangement wherein the input arrangement (on/off switch) enables a user to input commands to the circuit arrangement (security device 10) and signal processor (transponder logic 29), where the commands set at least one operation mode for the security device (fig. 1-fig. 3; col. 2, lines 6-17); an output arrangement where the output arrangement produces an output based on the input commands (col. 2, lines 52-68; col. 3, lines 1-7).

LaRosa discloses all the limitations above but fails to explicitly disclose the circuit arrangement includes a motion sensor.

However, D'Angelo discloses the circuit arrangement includes a motion sensor 23 (fig. 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate D'Angelo's motion sensor in LaRosa in order to detect accurately the movement of an article and alert the authorities to take appropriate measures to prevent the article from being stolen as taught by D'Angelo (col. 1, lines 11-63).

Regarding claim 9, La Rosa and D'Angelo disclose all the limitations in claim 8 and D'Angelo further discloses motion sensor detects excessive motion based upon the inputs commands (col. 8, lines 46-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate D'Angelo's motion sensor in LaRosa in order to detect accurately the

movement of an article and alert the authorities to take appropriate measures to prevent the article from being stolen as taught by D'Angelo (col. 1, lines 11-63).

Regarding claim 10, LaRosa discloses output arrangement emits one of at least an audible alarm (col. 2, lines 52-68).

Regarding claim 11, LaRosa and D'Angelo disclose all the limitations in claim 8 and D'Angelo further discloses the circuit arrangement 22 includes a microprocessor 32 and a memory arrangement (RAM 13), where the memory arrangement may store data and software that enable the functions of the circuit arrangement (fig. 1; fig. 3; col. 5, lines 28-47; col. 10, lines 25-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of D'Angelo in LaRosa. Doing so would have provided the system with the capability of storing functions of the device in order to issue an alert if a theft is subsequently attempted so users can take appropriate cautious to avoid the article from being stolen as taught by D'Angelo (col. 3, lines 10-41).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2636

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Benvenuti (US 6,166,652) discloses a system and method for locating misplaced items.

Russo et al. (US 5,640,144) discloses an RF/ultrasonic separation distance alarm.

Mardirossian (US 5,796,338) discloses a system for preventing loss of cellular phone or the like.

Olah (US 5,396,218) discloses a portable security system using communication cards.

Hampson et al. (US 6,052,054) discloses a portable scoreboard system with motion sensing for providing theft prevention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Previl whose telephone number is 703 305-1028. The examiner can normally be reached on Monday-Thursday. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on 703 305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-4700.

Daniel Previl  
Examiner  
Art Unit 2632

DP  
December 19, 2003

  
JEFFERY HOFSSASS  
SUPERVISORY PATENT EXAMINER  
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